

REMARKS

Claims 1-33 are now pending in the present application. The allowability of claims 4-8, 16, 25, 26 and 32 is gratefully acknowledged. Reconsideration of the remaining claims is respectfully requested.

Rejections under 35 U.S.C. §112:

Claims 19-33 were rejected as being indefinite under 35 U.S.C. §112, second paragraph. Applicant has removed reference to "the sleeve" in the relevant claims and has amended the claims to recite "at least a portion of the tubularly-shaped body portion."

Rejections under 35 U.S.C. §103:

Claims 1-3, 9-15, 17-24, 27-31 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dubost, U.S. Patent No. 5,249,845 in view of Nielson et al., U.S. Patent No. 5,297,854.

It is well established that in order to establish a prima facie case of obviousness, three basic criteria must be met, according to the Manual of Patent Examining Procedure, § 706.02(j). First, there must be some suggestion or motivation either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references) must teach or suggest all the claim limitations. Applicant respectfully submits that based upon a review of both the specification and the drawings of the patents cited, the Examiner has not demonstrated that all of the limitations of the claims are shown or suggested in any of the references separately or in combination with a reasonable expectation of success. Specifically, in order to find an invention obvious in light of a combination of references, there must be something present in the teaching of those references to suggest the claimed invention to one skilled in the art. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) (citing *In re Bergel*, 292 Fd.2d 955, 956-57, 130 U.S.P.Q. 206, 208 (CCPA 1961)). The mere fact the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 Fd.2d 1260, 1266, 23 U.S.P.Q.2d 1780,

1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Moreover, the Examiner must show reasons that the skilled artisan, *confronted with the same problems as the inventor and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (emphasis added).

Claim 1 defines a wheel cover assembly that comprises, among other things, a wheel clad assembly comprising at least one elongated tubularly-shaped extension comprising a first material, and at least one tubularly-shaped insulating sleeve comprising a second material different from the first material, wherein the sleeve is adapted to thermally insulate the wheel clad assembly from the vehicle wheel. In the rejections, it is argued that Dubost discloses a “sleeve [that] is adapted to thermally insulate the wheel covering from the vehicle wheel if made of non-metal.” There is no disclosure in the Dubost reference with respect to a selection of material, and specifically with respect to selecting different materials for different components disclosed therein. In fact, the only reference to materials within the Dubost reference occurs in Col. 4, Lines 21-23, which states “[t]he various component parts and hooking means just described may be for example made from a plastics [sic.] or other material.” Further, there is no indication that the sleeve has any insulative properties at all, and insulating the components from each other utilizing the identical materials would be relatively futile.

The Examiner also contends that the Nielson et al. reference teaches “a wheel cover comprising plastic or insulative tubular sleeve [sic] as disclosed in column 1, line 50” However, Nielson does not contemplate nor suggest a sleeve that is adapted to thermally insulate the wheel covering. Rather, Nielson teaches use of “a more durable resilient material.” Simply because a material has a higher strength or is more durable and resilient does not bear on its ability to insulate. Certainly, the Nielson et al. reference discloses more durable resilient materials, including sophisticated plastics that may be highly conductive of heat and thus not thermally insulative as required by the claims of the instant application.

Moreover, it is argued that the motivation for combining that which is disclosed by Nielsen et al. with that which is disclosed by Dubost is that the "insulative sleeve" of Nielson would reduce the heat conduction within the wheel cover as taught by Dubost in the event of a flat tire. No such suggestion or teaching is found in any portion of either the Nielsen et al. or Dubost references, and it appears this is a solution to a problem not set forth or contemplated by the art. Similarly, it is argued that the combination is motivated by a need to prevent failure in a wheel cover retention due to overheating. Again, Nielsen et al. and Dubost do not teach, motivate or suggest addressing such a problem.

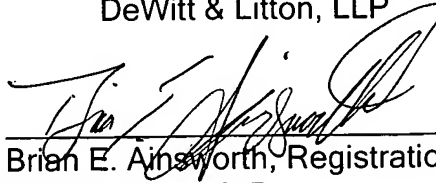
Accordingly, claim 1 is in condition for allowance. Claims 2-18 are dependent from claim 1, which is in condition for allowance, and are therefore also in condition for allowance.

The above noted statements are also supportive of the allowance of claim 19. Accordingly, claim 19 is in condition for allowance. Claims 20-33 are dependent from claim 19 which is in condition for allowance, and are therefore also in condition for allowance.

The Applicant has made a concerted effort to place the present application in condition for allowance. A Notice to this effect is earnestly solicited. In the event that there are any remaining formalities or issues needing Applicant's assistance, Applicant requests the Examiner to call the undersigned attorney. Also, if the Examiner believes that a telephone or in-person interview would be helpful, Applicant requests that the Examiner call the undersigned attorney at 616/949-9610.

Respectfully submitted,

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP



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Brian E. Ainsworth, Registration No. 45 808
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

BEA:BRC:dlc:kjc